

REMARKS

STATUS OF THE CLAIMS

Claims 1-28 are pending in this application. Claim 22 has been amended herein. No new matter was introduced through this amendment.

RESTRICTION REQUIREMENT

In the Office Action of January 31, 2006, the Examiner required restriction of the claims to the following three groups:

- I. Claims 1-21, drawn to a method of identifying a subset of genes;
- II. Claims 22-28, drawn to a method of correlating gene expression with a sample phenotype; and
- III. Claims 29-35, drawn to a kit.

Applicant respectfully submits that claims 29-35 are not pending in the present application in view of the Preliminary Amendment submitted by the Applicant on September 10, 2003, with the filing of the above-mentioned patent application. Applicant respectfully requests that the Examiner enter the amendments included in the Preliminary Amendment. Assuming that the Examiner enters these amendments, Applicant will respond to this Restriction Requirement regarding Groups I and II only.

Applicant respectfully traverses the restriction of the invention into Groups I and II. Applicant submits that claim 22 depends from claim 1 and claims 23-28 each depend from claim 22 or one of the intervening dependent claims. Applicant has amended the structure of claim 22 to further clarify that it is a dependent claim which depends from claim 1. Applicant notes that the scope of claim 22 has not been changed by this amendment. Since claim 22 depends from claim 1, separating the invention as the Examiner suggested would result in dividing the group of claims depending from claim 1 into separate inventions. The Examiner argued the Groups I and II are related as combination and subcombination. The Examiner further stated that the "combination (Group II) as claimed does not require the particulars of the subcombination

(Group I).” However, since claim 22 of Group II depends from claim 1 of Group I, claim 22 (and the claims that depend therefrom) include all of the limitations of claim 1. To practice the method of claim 22, one must also perform the steps of claim 1. Further, dividing the invention in this manner would prohibit the Applicant from claiming the invention as it is contemplated or capturing the intended scope of the invention. Thus, Applicant respectfully requests withdrawal of this restriction requirement

Applicant further notes that a species election was required with regard to Group II. If the Examiner agrees to withdraw the restriction requirement between Groups I and II, merging these two Groups together and if this species election is maintained, Applicant then provisionally elects the species of Table 5 for claims 24-28 (assuming the Examiner maintains this species election requirement).

If the Examiner does not agree to withdraw the restriction requirement between Groups I and II, Applicant alternatively suggests that the Examiner consider limiting initial examination to a reasonable number of species encompassed by each of the claims, instead of dividing the claimed invention into two separate Groups. See 37 C.F.R. § 1.146. This practice strikes an appropriate balance between the concerns of the Patent Office regarding administrative considerations and unduly burdensome examination, and the clear constitutional and statutory rights of an inventor to claim an invention as it is contemplated, provided the dictates of 35 U.S.C. § 112 are complied with. See MPEP at 803.02. Unlike the restriction requirement provided in the Office Action of January 31, 2006, a species election does not preclude the Applicant from pursuing what is substantially the original form of the claims 1-28 in subsequent prosecution, nor does it force an applicant to file multiple divisional applications for the method of identifying a subset of genes, which would be incapable of capturing the intended scope of the invention.

In the event that the Examiner does not withdraw the Restriction Requirement of January 31, 2006, as suggested, or treat it as a species election (as a suggested alternative), but instead

maintains the Restriction Requirement as stated in the Office Action, Applicant provisionally elects Group I (claims 1-21).


CONCLUSION

Withdrawal of the pending rejections and reconsideration of the claims are respectfully requested, and a notice of allowance is earnestly solicited. If the Examiner has any questions concerning this Response, the Examiner is invited to telephone Applicant's representative at (650) 335-7185.

Respectfully submitted,
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